APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,182	01/03/2001	Robert Carl Silkey	258/083	2812

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EXAMINER
JANVIER, JEAN D

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 10/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/754,182	SILKEY ET AL.
	Examiner	Art Unit	
	Jean D Janvier	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____ .

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _3041_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _30-41_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

        1. ☐ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ .

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

Specification

The title of the invention is not descriptive so as to help one having ordinary skill in the

art understand the nature of the subject matter. A new title is required that is clearly indicative of

the invention to which the claims are directed. See 37 CFR 1.72.

Information Disclosure Statement

The references to a plurality of web site addresses as shown on PTO Form 1449 does not

constitute a proper Information Disclosure Statement (IDS) under 1.56. Applicant should access

www.archive.org and print out the pertain web pages and submit them for consideration in a

future correspondence.

Status of the claims

Original claims 1-29 were canceled following a restriction requirement. New claims 30-

41 are now pending in the Instant Application.

Claim Objections

Claims 37-41 are objected to because of the following informalities:

It appears that claims 37-41 should depend on independent claim 36 rather than

independent claim 30.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign
country or in public use or on sale in this country, more than one year prior to the date of
application for patent in the United States.

Claims 30 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Shane, US

Patent 5,793,972.

As per claims 30 and 36, Shane discloses a system for providing an interactive response

to direct mail programs comprises a recipient database, a mail generator, and a web server

computer operationally connected through the Internet to remote computers accessible by direct

mail recipients or screened users. The recipient database stores data records containing

addressing information such as the name, mail, fax or e-mail address, and a unique personal

identification code or PIN number for each direct mail recipient (recipient database stores

mailing list parameters). The mail generator retrieves recipient data from the database and

generates a multiplicity of direct mail pieces each displaying the name, address, and a uniform

resource locator or URL containing the personal identification code for a screened or targeted

recipient. The targeted or responding recipient accesses the web server or central computer by

entering the uniform resource locator or URL displayed on the received direct **mail piece or**

mailer, mailed via the post office or e-mailed to the targeted recipient, into a local web browser

outputted on his remote computer or second device (logging step). The web server computer

retrieves recipient data from the recipient database correlated to the personal identification code

or PIN contained in the uniform resource locator and uses this recipient data to create a unique

interactive web page, where the recipient or respondent views personal messages or ads directed

to his attention.

Here, recipient database 12 stores recipient data records 22 containing recipient

addressing information, such as the recipient's name and address and a unique personal

identification code for each intended direct mail recipient. Typically, the recipient data (mailing

list) contained in the recipient data records 22 are obtained from a mailing list broker and entered

or stored into the recipient database 12. The recipient database 12 may also include demographic

and tracking information for each recipient (col. 3: 64 to col.4: 5).

Further, mail generator 14, typically located in a lettershop, is electronically coupled to

recipient database 12 so as to be capable of retrieving the recipient data (client's profiles) for

each intended or targeted (via a screening or filtering process) direct mail recipient or user.

Preferably, mail generator 14 of fig. 1 comprises a computer system 24 including a printer 25 for

printing direct mail pieces 26 displaying thereon the name, address and uniform resource locator

(or URL related to a web site) containing a unique personal identification code, for each intended

or screened recipient (composing a personalized message to be presented to a targeted user based

on a promotion or event, which matches the user's profile-fig. 3). Mail generator 14 also

typically addresses and prepares direct mail pieces or mailers 26 for mailing through a postal

system 28, which delivers mail pieces 26 to a plurality of locations 29, typically the home or

office of each targeted or screened recipient (col. 4: 6-19).

In short, Shane discloses in fig. 4, the steps (of the method 100) carried out by apparatus

10. An advertiser (user) obtains one or more mailing lists from a list broker (by leasing or

purchasing the mailing lists), wherein the mailing lists (raw data) are sent to a data house, along

with any in-house lists and suppression lists that the advertiser has previously generated (Block

102). The data contained on the mailing and in-house lists are processed or filtered to eliminate

duplicates and to prevent mail from being sent to certain individuals or addresses on the

suppression lists, which the advertiser has previously determined would be inappropriate, to

generate a recipient database 12 (screening the mailing lists to eliminate duplicate names or to

prevent delivery to certain recipients' in a suppression list based at least on their addresses or

locations, etc -Block 104) (using a modified or screened mailing list of recipients to send the

mailing pieces to). In a typical direct mailing, the direct mail pieces 26 would then be printed by

merging a pre-prepared form letter with data from the mailing lists, and the direct mail pieces or

mailers 26 would be prepared for mailing and deposited with the post office 28 (col. 5: 63 to col.

6: 11).

See abstract; figs. 1-4; col. 2: 22 to col. 3: 32.

Shane also supports, in general, the steps of printing users' names and addresses on mail

pieces or mailers, containing advertising or promotions, and mailing the mail pieces to the users

by a data house (processing mail pieces). The users may respond via phone calls or by ordering

products featured in the mail pieces. (Col. 1: 30-67). It should further be understood that the

mailing list (or a screened mailing list), as disclosed by Shane, could be used in more than one

marketing campaign (i.e. to run a first, second, third .... marketing campaign).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign
country or in public use or on sale in this country, more than one year prior to the date of
application for patent in the United States.

Claims 30, 32-33, 36 and 38-39 are rejected under 35 U.S.C. 102(b) as being anticipated

by Plainshield, US Patent 5,893,075.

As per claims 30, 32-33, 36 and 38-39, Plainfield discloses an interactive, customer-

accessible data processing system embodied in a programmed personal computer that induces

customers of a restaurant, store or other business to enter information (profile information) about

themselves into the system database. The information, which may include names, addresses

(demographic data), dates and answers to survey questions, is entered into data fields displayed

on a display screen coupled to a terminal accessible to the customers. The system enables a

business to generate promotional messages tailored to customers based on the customer-entered

information (profile). For instance, a business can readily generate birthday offer letters (sending

birthday messages or sending promotional birthday messages or offers) to customers based on

their name, address, and birth date simply by selecting an option provided by the system. To

induce customers to enter the necessary information or profile data, the system flashes an

incentive message on the computer or terminal display screen. The message may offer to enter a

customer into a drawing or other contest in return for the customer entering the necessary

information into the system (See abstract).

Here, the interactive data processing system, as described above, includes a data entry

device such as a personal computer accessible to the customers to enter data about themselves

into the system database. The system further comprises a customer database and means for

providing a plurality of customer data fields associated with the customer database for storage

and later retrieval and use. Customers use the data entry device, such as a keyboard, to enter their

data into the data fields and thereby into the customer database. Means are also included in the

system for generating promotional messages such as mailings (personalized mailers) to

customers, based on the data (customers' profile) entered by the customer into the customer

database. To stimulate or encourage customers to enter data, the system may include means for

inducing customers to enter data about themselves into a customer database, such as generating a

message on the computer display screen offering an incentive to the customer for entering such

data. Moreover, the means for generating promotional messages may be constructed to generate

letters (personalized mailers) tailored to customers based on their entered data. The bodies of

these letters may be stored in a system library and selected as appropriate for the customer, such

as birthday greetings, anniversary congratulations, dinner specials, etc.

In short, the present system includes computerized methods, not limited to the data

processing system, for surveying and targeting customers. In a preferred embodiment, the

method may include providing a customer database, a plurality of customer database fields and a

data entry device for customers to enter profile data into the fields and hence in the customer

database. **Promotional messages are then being generated and sent to the customers based**

on the data entered by the customers (or based on the customers' profile stored in the

database). Moreover, a method or process for inducing customers to enter the profile data, such

as by displaying a message on a display screen terminal offering an incentive to a customer for

entering such data, is provided.

Col. 1: 55 to col. 2: 27.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or
> described as set forth in section 102 of this title, if the differences between the subject
> matter sought to be patented and the prior art are such that the subject matter as a
> whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability
> shall not be negatived by the manner in which the invention was made.

Claims 31-35 and 37-41 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Shane, US Patent 5, 793, 972

As per claims 31-35 and 37-41, although Shane teaches a system for presenting a personalized message, such as a promotional message, to a user, however, Shane does not expressly disclose generating a holiday greeting, a birthday or an anniversary message, an appointment or a prescription reminder.

However, it is common practice for a user (sender) to send a post card or greeting card to another user (recipient) for a special event or occasion, wherein the post card contains a personal message written by the sender for the recipient and an advertising message. Furthermore, it is well documented that a sender can electronically create a personal greeting card, containing a personal written message such as a birthday (or anniversary) message and information regarding a special gift, which is subsequently sent to a recipient for his birthday (or anniversary). Additionally, it is customary for a business such as a car dealership to send a reminder to a customer reminding him that it is time that his identified car have an oil change, for a doctor's office to send an appointment reminder to a patient reminding him of an appointment already scheduled or reminding him to make an appointment for his annual physical. Moreover, it is well supported in the art for businesses to send holiday greeting cards to their customers thanking them for their patronage or business, wherein the greeting cards contain holiday greeting messages and company promotional messages.

Finally, sending a birthday holiday message, an anniversary message, an appointment reminder or prescription reminder or any other type of message to a user is a matter of desires.

("Official Notice" or Public Disclosure)

Therefore, an ordinary skilled artisan would have been motivated at the time of the

invention to incorporate the above Public Disclosure into the system of Shane so as to generate a

by a sender (or a business entity) a personalized message, such as, a holiday greeting message, a

birthday or anniversary message, an appointment or prescription reminder, to be sent to a user

recipient based on a special occasion and wherein a unique promotional message may be

appended to the personalized message, thereby taking advantage of a special event or occasion to

generate and send a personalized correspondence or message to a targeted user recipient, which

includes a targeted promotion for a product or service associated with a manufacturer or local

vendor and wherein the sender (or business entity) of the personalized correspondence or mailer

or mail piece is compensated for distributing the manufacturer's or the local vendor's

promotional message to the recipient of the correspondence and wherein the revenues earned by

the sender or business entity for disseminating the promotional message help the sender increase

his business bottom line or pay for his overheads.

Claims 31, 34, 35, 37, 40 and 41 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Plainfield, US Patent 5, 893,075.

As per claims **31, 34, 35, 37**, 40 and 41, although Plainfield teaches a system for

presenting a personalized message, such as a promotional message, birthday or

anniversary message to a user, however, Plainfield does not expressly disclose generating

a holiday greeting, an appointment or a prescription reminder.

However, it is common practice for a user (sender) to send a post card or greeting card to another user (recipient) for a special event or occasion, wherein the post card contains a personal message written by the sender for the recipient and an advertising message. Furthermore, it is well documented that a sender can electronically create a personal greeting card, containing a personal written message such as a birthday (or anniversary) message and information regarding a special gift, which is subsequently sent to a recipient for his birthday (or anniversary). Additionally, it is customary for a business such as a car dealership to send a reminder to a customer reminding him that it is time that his identified car have an oil change, for a doctor's office to send an appointment reminder to a patient reminding him of an appointment already scheduled or reminding him to make an appointment for his annual physical. Moreover, it is well supported in the art for businesses to send holiday greeting cards to their customers thanking them for their patronage or business, wherein the greeting cards contain holiday greeting messages and company promotional messages.

Finally, sending a birthday holiday message, an anniversary message, an appointment reminder or prescription reminder or any other type of message to a user is a matter of desires.

("Official Notice" or Public Disclosure)

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the above Public Disclosure into the system of Plainfield so as to generate a by a sender (or a business entity) a personalized message, such as, a holiday greeting message, a birthday or anniversary message, an appointment or prescription reminder, to be sent to a user recipient based on a special occasion and wherein a unique promotional message may

be appended to the personalized message, thereby taking advantage of a special event or

occasion to generate and send a personalized correspondence or message to a targeted user

recipient, which includes a targeted promotion for a product or service associated with a

manufacturer or local vendor and wherein the sender (or business entity) of the personalized

correspondence or mailer or mail piece is compensated for distributing the manufacturer's or the

local vendor's promotional message to the recipient of the correspondence and wherein the

revenues earned by the sender or business entity for disseminating the promotional message help

the sender increase his business bottom line or pay for his overheads.

Conclusion

Although the following references were not used in the Office Action, they were highly

considered by the Examiner. Applicants are further directed to consult these references.

US Patent 6, 567, 786B1 to Bibelnieks discloses a method, and system for increasing the

efficiency of customer contact strategies is disclosed. Customers are analyzed based upon

historical criteria; a promotional plan (a group of promotion events implemented or to be

implemented over a particular time period) is analyzed to determine the effect of each promotion

event on the other promotion events in the promotional plan; and, based on this analysis, the

optimal promotion stream (a specific subset of the promotional plan to be sent to customers or a

group of similar customers) is determined so as to maximize the ROI of the promotional plan as

a whole.

US Patent 6, 076, 101 to Kamakura discloses an electronic mail processing system for distributing an e-mail message from a sender to recipients, which encourages the recipients to open, read, and reply to the e-mail message sent from the sender. An original e-mail message sent from a sender via a sender terminal is stored in an outgoing message storage unit. An outgoing mail information registration unit stores a list of recipients to whom the e-mail message should be delivered, as well as storing information on bonus points. A message sending unit encloses bonus point information in the e-mail message and distributes it to the recipients included on the list. Upon receipt of a reply message from one of the recipients, a reception process unit gives a predetermined number of bonus points to the recipient. Each recipient's bonus points are accumulated in a recipient information storage unit, and he/she can redeem his/her bonus points for gifts depending on the accumulated points. This structural arrangement encourages the recipients to open the sender's message and write reply messages thereto in expectation of the redeemable bonus points, thus allowing the original message sender to collect more reply messages from the recipients than normally expected.

US Patent 6,714,916 to Robertson discloses a network-computer-based personal contact manager system, wherein users of networked clients maintain and update a set of user information, which is stored in a relational database on a networked server. The personal contact manager system allows each user to specify on an individual basis which of their contacts are permitted to access respective data of their user information. In some cases, and assuming permission is granted, the system will issue notifications (e.g., by e-mail) to a user's contacts when the user changes his information or when a preset event, such as a birthday, as defined by

the user, is to occur. The system also allows users to find contacts based on common group

affiliations and notifies users when there are coincidences in their data (e.g., travel plans,

astrological compatibility). The personal contact manager system supports the retrieval of

information on the contacts of contacts, assuming such as permission has been granted by the

contacts and their contacts, and can also be used to synchronize the server database with a PIM

database of the user and any contacts of the user who have the appropriate permissions (See

abstract).

US Patent 4,782,521 to Barlett discloses a time manager for a personal terminal generally

characterized as a things-to-do file in which the user inputs a to-do reminder message along with

a data and time that the terminal user wants to be alerted (reminded). The notion of a terminal

time manager is advanced by displaying reminder messages directed to calling a named entity

that is contained in the terminal telephone directory and by automatically calling the named

entity when the user points to the displayed reminder. If the user inputs the actual telephone

number to be called in place of the named entity, then the telephone number will be called even

though the telephone number is not contained in the directory (See abstract).

Any inquiry concerning this communication from the Examiner should be directed to

Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally

be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner

by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached

at (703) 305- 8469.

For information on the status of your case, please call the help desk at (703) 308-1113.

Further, the following fax numbers can be used, if need be, by the Applicant(s):

After Final-   703-872-9327

Before Final -703-872-9326

Non-Official Draft- 703-746-7240

Customer Service- 703-872-9325

10/20/04   Jean D. Janvier

   JDJ   Patent Examiner

                Art Unit 3622